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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,917	07/10/2003	Wolfgang Neuberger	BJA338D	4236

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BOLESH J. SKUTNIK
CERAMOPTEC INDUSTRIES, INC.
515 SHAKER RD.
EAST LONGMEADOW, MA 01028

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,917

Applicant(s)

NEUBERGER

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 12, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

In the Pre-Appeal Brief conference request, applicant argues that the examiner has no motivation to combine the references in the base combination. The examiner has expanded on the motivation used to combine the references, so as to render the line of reasoning more clear. Applicant also makes reference to the examiner discussing an economic motivation. The examiner apologizes for any misunderstanding. There was in fact a spelling error in the previous response which erroneously described “spending losses”, when the intended phrase was “bending losses” which are discussed by Dabby. The error has been remedied in the remarks below. The examiner also notes that claim 14 was erroneously listed as rejected on the cover sheet of the previous office action. As the only rejection applied to claim 14 was the double patenting rejection, which was obviated by the terminal disclaimer, claim 14 is objected to as depending from a rejected base claim, as set forth below.

Applicant argues that the claims are allowable over the art of record. Applicant asserts that the rejections are improper because the present invention is not made obvious by the combination of references, because the combination fails to satisfy the every element requirement, and that the present invention is further patentable over the references, because there's no suggestion to modify or motivation to combine the reference teachings. The examiner must respectfully disagree. Applicant notes correctly in claim 1 requires at least one coherent light source of a suitable wavelength, at least one oligomode optical waveguide couple to said source. Wherein the wave the guide has a low mode transmission at said wavelength, and at least one means to selectively leak radiation of said wavelength from at least one preselected position along the length of said waveguide. In analyzing the McDaniel reference, applicant asserts that McDaniel discusses the use of a "multi-chromatic source". While this is true, the

examiner respectfully notes that McDaniel clearly and specifically calls for the use of laser diodes as the source, lasers clearly emit coherent radiation (see column 26, lines 52 to 53), and therefore satisfy the coherent light source of a suitable wavelength requirement of claim 1. Applicant then asserts that the McDaniel reference fails to disclose a "source for leaking radiation along the length of the waveguide". The examiner must respectfully point that the requirement in the claim is that the radiation leak at at least one location along the length of the fiber is satisfied by the exiting of the radiation at the fiber end, use the fibers with the coherent source is taught by McDaniel, at figure 17, and at column 10, lines 52-62.

With regard to the Dabby reference, applicant acknowledges the teaching of an oligomode waveguide therein. However, applicant then goes on to assert that the remainder of the reference teaches away from the use of an oligomode waveguide. This is not entirely accurate, however. As can be see by the disclosure at column 5 Dabby states "The same principle is applicable where more than two modes can be established as in an oligomode waveguide. However, it is evident from test results discussed below, the **essential** objectives are obtained by establishing a balanced dual-mode conditions." (emphasis added). As applicant is no doubt well aware, the teachings of a reference are not merely limited to the preferred embodiments. And the fact that an oligomode waveguide can be used, as specifically stated by Dabby is not negated by the fact that Dabby uses other fibers as well. Applicant also alleges that there's no motivation to combine the references. This is clearly not the case, however. The examiner has specifically specified the motivations in the final sentence of the rejection. In addition to these motivations is also noted that the device of Dabby reduces bending losses. This would also be a motivation to include the fiber of Dabby in the device of McDaniel as more of

the therapeutic radiation would reach the treatment site, despite bends in the fiber.

With regard to the remainder of the claims rejected under the base combination.

Applicant merely argues that McDaniel teaches away from using a clad fiber citing column 6, lines 21 to 20. This apparently refers to the Dabby reference, wherein at column 6, lines 21 to 20, and there is discussed a dual mode waveguide, which includes a cladding. Thus this argument is not convincing for the reasons set forth above regarding the teachings of non-preferred embodiments.

With regard to the rejection including Mori, applicant argues the inclusion of the structure of Mori it would limit the intended use of the device. The examiner notes that applicant's comprising-type claims allow the examiner to employ references which include structures not recited in the claim. Thus, even assuming that this intended use, which is not even recited in the claims to which Mori is applied, were contained within the operative portion thereof, the rejection would still be applicable thereto. With regard to the rejection of claim 11, applicant appears to argue that the rejection is not proper because there is no motivation to combine the two primary references to the tertiary reference, asserting that there is no reason to include an optical fiber in the device of Prescott. However Prescott appears to disagree with applicant's assessment, as evidenced by the passage at column 14, line 65 to column 15 line 52. With regard to claim 13, applicant asserts that there is no reason to combine McDaniel and Sullivan because they are two competing methods. The examiner must respectfully disagree. Sullivan clearly teaches the utility of providing therapeutic or radiators of the floor of a room, and applicant has provided no cogent argument as to why the combination as suggested by the examiner does not proper. Therefore these arguments are not convincing.

A double patenting rejections have been withdrawn in view of the terminal disclaimer submitted by applicant, which was approved on September 27, 2005

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel in combination with Dabby. Mc Daniel teaches a device and method for irradiating tissue to produce biostimulation using optical fibers, wherein any type of tissue can be irradiated. Dzbby teaches the use of oligomode optical fibers. It would have been obvious to the artisan of ordinary skill to employ a device and method as taught by Dabby in the device and method of McDaniel, since McDaniel provides no particular structure for the fiber optic applicator, and thus, the person having ordinary skill in the art would look to the fiber optic art to find an appropriate form for the fiber optic suggested by McDaniel to take, thus producing a device and method such as claimed.

Claims 2, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel in combination with Dabby as applied to claims 1, 3, 4, 6, 8, and 9 and further in combination with Mori. Mori teaches the use of cut away sections of waveguide that leak radiation along their length. It would have been obvious to the artisan of ordinary skill to employ a device and method as taught by Mori in the device and method of McDaniel as modified by Dabby, since McDaniel provides no particular structure for the fiber optic applicator, thus producing a device and method such as claimed.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel in combination with Dabby as applied to claims 1, 3, 4, 6, 8, and 9 and further in combination with

Diamantopoulos et al. Diamantopoulos et al. teach controlling the timing of pulses using a timer. It would have been obvious to the artisan of ordinary skill to employ the timer of Diamantopoulos et al in the method of McDaniel, since McDaniel provides no mechanism for timing the pulse application, thus producing a method as claimed.

Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel in combination with Dabby and Prescott. The teachings of McDaniel and Dabby are as set forth above. Prescott teaches applying laser therapy to a wound prior to covering the wound with a dressing. It would have been obvious to the artisan of ordinary skill to applying laser therapy to a wound prior to covering the wound with a dressing in the method of McDaniel, as taught by Prescott, since McDaniel provides specific protocol for dressing application, or to employ the parameters for treatment set forth in the method of McDaniel in the method of Prescott, since Prescott discloses no particular treatment parameters, and in either case to employ the fiber of Dabby, since neither Prescott nor McDaniel teach any particular fiber structure for the fiber optic applicator, and thus, the person having ordinary skill in the art would look to the fiber optic art to find an appropriate form for the fiber optic suggested by Prescott or McDaniel to take, thus producing a method as claimed.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel in combination with Dabby as applied to claims 1, 3, 4, 6, 8, and 9 and further in combination with Sullivan. Sullivan teaches lining the floor of an enclosure with treatment LEDs. It would have been obvious to the artisan of ordinary skill to employ the radiator layout of Sullivan in the method of McDaniel, since the layout of McDaniel is not critical and provides no unexpected

results, and since this radiator configuration is equivalent to the use of vertical panels, as shown by Sullivan, thus producing a method as claimed.

Claim 14 objected to as depending from a rejected base claim. Claim 14 contains allowable subject matter and would be allowable if it were written in independent form, including all the limitations of the claim(s) from which it depends.

Applicant's arguments filed September 27, 2005 and May 12, 2006 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam, can be reached on Monday, Tuesday, Wednesday, and Thursday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David M. Shay", with a stylized flourish at the end.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330